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Act

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,745	01/22/2001	William Gerrie	86794.000003	1272
23387	7590	01/13/2004	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			PARADISO, JOHN ROGER	
		ART UNIT		PAPER NUMBER
		3721		
DATE MAILED: 01/13/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,745	GERRIE ET AL.	
	Examiner John R. Paradiso	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9, 15 and 16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed "easel forming cuts" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WENKMAN.
4. WENKMAN discloses an integral mailer and frame with a frame front panel (6) with an aperture (15) therethrough. A rear frame panel (7) is attached to the frame front panel by means of a first fold line (32), the rear frame panel including easel forming cuts (38, 40). A mailer front panel (8) is connected to the rear frame panel by means of a second fold line (80). A closure flap (9) is connected to the mailer front panel by means of a third fold line (82). The panels are arranged so that the frame front panel can overlay the frame rear panel which can in turn overlay

the mailer front panel, all of which are contiguous pieces. An adhesive area is disclosed on the frame front panel so as to engage the closure flap when the panels overlay one another.

(See WENKMAN col. 4:62 – 7:L10, and Fig. 1.) The panels of WENKMAN are substantially the same size and the fold lines are all parallel to one another.

5. WENKMAN does not disclose a mailer rear panel connected to the mailer front panel by a fold line; WENKMAN also does not specifically disclose the adhesive area on the closure flap.

6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a rear mailer panel to the front mailer panel of WENKMAN in order to provide more room for the user to write, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

7. Regarding claim 4, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of WENKMAN by moving the adhesive area to the mailer closure panel in order to make a more intuitive process of closure for the end user, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

8. Note that the tear strip is being read on the third fold line itself, since fold lines are inherently weakened areas of a card, paper, or board material.

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Response to Arguments

9. Applicant's arguments filed 10/22/2003 have been fully considered but they are not persuasive.

10. Applicant states on page 6 of his Response that "In the Examiner's analysis, the mere provision of another panel to provide more writing area renders the provision of a second mailing panel obvious. This is not the case. The mere provision of an extra writing panel does not necessarily provide the structure inherent in the use of the extra panel as a second mailer panel."

However, as stated above,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a rear mailer panel to the front mailer panel of WENKMAN in order to provide more room for the user to write, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

The addition of a rear mailer panel does indeed provide the structure as claimed. Applicant's argument may be directed at the idea that the intended use (as a mailer panel rather vs. a writing panel) is different, however, Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Further, a reference that contains all the structure defined in a claim, but not the recited use, anticipates the claim because a new use does not make an old product patentable. In re Schreiber, 128 F.3d 1473, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997)

11. Applicant states on page 6 of his Response that ‘Dependent claim 5 specifies that the panel structure and fold lines allow the disposition of ‘the panels in an over laying configuration having an order of ...’. Even if it were obvious to add a second ‘mailer’ panel to the Wenkman structure .. there is no suggestion for providing the structural arrangement as claimed such that there is the claimed overlaying configuration.

However, since the addition of a rear mailer panel to the invention of WENKMAN results in the same structure including the same sequence of panels with the same foldable connections, it can indeed be folded in the same manner as the claimed invention.

12. Applicant states on pages 6-7 of his Response that “Independent claim 7 is directed to the blank for making the combination picture frame and mailer. The claim recites that the mailer front and rear panels are ‘symmetrical about the third fold line’. Even if it were obvious to add a second mailer panel to the Wenkman structure, nothing in Wenkman suggests or makes obvious having the mailer panels ‘symmetrical about the third fold line’.

However, since the rejection above is based on a duplication of the mailer front panel (8) of WENKMAN, the additional panel (discussed above as the added mailer rear panel) would be

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connected to the mailer front panel (8) of WENKMAN by a fold line, which would be read on the claimed "third fold line". Since the additional panel would be a duplication of the mailer front panel (8) of WENKMAN, it would be the same size and would therefore inherently be symmetrical about the new "third fold line".

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700

Examiner John Paradiso: (703) 308-2825

January 8, 2004

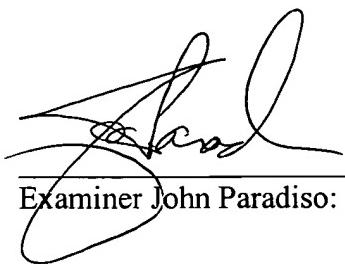
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Fax (Official):	(703) 872-9306

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